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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,713	01/30/2002	Arnold Wade Lomas	DC4955	8182

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DOW CORNING CORPORATION CO1232  
2200 W. SALZBURG ROAD  
P.O. BOX 994  
MIDLAND, MI 48686-0994

EXAMINER

ROBERTSON, JEFFREY

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/060,713

Applicant(s)

LOMAS ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/30/02.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18, 22-24 and 26-29 is/are allowed.
- 6) ☒ Claim(s) 19-21 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: on page 20, paragraph [0042], applicant's definition of "preparable" is indefinite. The definition that preparable intends to cover a composition that "could be" made by the cited method, is contrary to the accepted meaning of preparable, which is "capable of being prepared." While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. For claim 19, as set forth above, the term "preparable" as defined in the specification is indefinite because although applicant states that the term is broader than the product by process claims, the meets and bounds of the claim cannot be determined in light of applicant's definition. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The

term "preparable" in claim 19 is used by the claim to mean "could be prepared," while the accepted meaning is "capable of being prepared."

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 19, 20, 21, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by either Fujiki et al. (U.S. Patent No. 4,721,764) or King et al. (U.S. Patent No. 5,696,209).

For claims 19, 20, and 25, Fujiki ('764), in column 2, lines 1-45, Fujiki ('764) teaches that an organopolysiloxane containing unsaturated groups is reacted with an organopolysiloxane containing hydrogen groups in the presence of a platinum catalyst. In column 3, lines 50-52, Fujiki ('764) teaches vinyl-terminated polysiloxanes. In column 5, in the fourth structure, Fujiki ('764) teaches an organopolysiloxane containing hydrogen atoms and an alkoxysilyl group. In column 10, lines 14-20, Fujiki teaches another organopolysiloxane containing alkoxysilyl groups and hydrogen atoms. For claim 21, both of these organopolysiloxanes have the group  $-(CH_2)_3Si(OMe)_3$ , which falls within the definition of the alkoxysilyl group in claim 21, where  $n=0$ ,  $R^5$ =methyl, and  $X=-(CH_2)_3-$ . In column 5, lines 46-60, Fujiki ('764) teaches the presence of a platinum

catalyst. In column 7, lines 50-57, Fujiki ('764) teaches that the composition is crosslinked.

Fujiki ('764) does not teach that the product contains a diluent, however, claim 12, does not appear to require that a diluent is present in the product, but only in the cross-linking stage. Thus the "products" of Fujiki ('764) would constitute the products of the cross-linking of applicant's method where the diluent has been removed.

Fujiki ('764) does not specifically teach the method set forth by applicants. It is noted that Claims 20, 21, and 25 are product-by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). For claim 19, it appears that the polymers produced in Fujiki ('764) are also "preparable" via the method set forth in claim 19.

For claims 19, 20, and 25, in column 6, lines 26-56, King teaches a SiH containing polyorganosiloxane and an alkenyl functional polydiorganosiloxane, where one of the siloxanes should contain an alkoxysilyl radical. For claim 21, King teaches that the alkoxysilyl group is of the formula  $-ZSiR^1_x(OR^2)_{3-x}$ , which falls within the definition set forth by applicant, since  $x=0$  or  $1$ ,  $Z$  can be alkylene, and  $R^2$  is a monovalent hydrocarbon radical. In column 5, lines 54-55, King teaches a vinyl-

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terminated polydimethylsiloxane. In column 4, line 56, King teaches a hydrosilation catalyst. In column 7, lines 32-43, King teaches that the composition is cured.

King does not teach that the product contains a diluent, however, claim 12, does not appear to require that a diluent is present in the product, but only in the cross-linking stage. Thus the "products" of King would constitute the products of the cross-linking of applicant's method where the diluent has been removed.

King does not specifically teach the method set forth by applicants. It is noted that Claims 20, 21, and 25 are product-by process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). For claim 19, it appears that the polymers produced in King are also "preparable" via the method set forth in claim 19.

#### ***Allowable Subject Matter***

7. Claims 1-18, 22-24, and 26-29 are allowed. None of the references applied above teach a composition where there is a crosslinked siloxane of the composition set forth by applicant in the presence of a diluent or a personal care composition. These references also fail to teach the method of reacting a diene, diyne or ene-yne with a Si-H functional siloxane where each of the components is dispersed in a diluent and at least one contains an alkoxysilyl group.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hill et al. (U.S. Patent No. 5,665,804), Zhang (U.S. Patent No. 5,889,108), Meinhardt et al. (U.S. Patent No. 5,969,035), and Horne et al. (U.S. Patent No. 6,291,563) are cited for teaching similar compositions as applicant used in the personal care industry. None of these references teach the presence of an alkoxysilyl group on the components. Arkles (U.S. Patent No. 4,714,739), Stepp et al. (U.S. Patent No. 5,420,222), and Joffe et al. (U.S. Patent No. 5,840,800) are cited to show polymers containing alkoxysilyl groups.

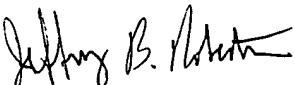
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (703) 306-5929. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

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Jeffrey B. Robertson  
Examiner  
Art Unit 1712

JBR  
February 10, 2003